

## **REMARKS**

This is meant to be a complete response to the Office Action mailed December 20, 2004. In the Office Action, the Examiner indicated that claims 3, 12, 22 and 31 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant acknowledges with appreciation the indication of allowability of claims 3, 12, 22 and 31. Such claims have been canceled herein and rewritten as independent claims 62-65, respectively. Therefore, Applicant respectfully submits that newly added claims 62-65 are in condition for allowance. Favorable action is respectfully solicited.

In the Office Action, the Examiner rejected Applicant's claims 1-61 under 35 U.S.C. 101. Claims 1-2, 5-11, 14-21, 24-30, 33-44, 46-52 and 54-61 were rejected under 35 U.S.C. 103(a) as being obvious over Weder (US 6,742,316) in view of Applicant's admission in the IDS filed on October 22, 2004, and claims 4, 13, 23, 32, 45 and 53 were also rejected under 35 U.S.C. 103(a) over the same combination of references.

### Applicant's Response to the 35 U.S.C. 101 Rejection

In the Office Action, the Examiner rejected Applicant's claims 1-61 under 35 U.S.C. 101. In support thereof, the Examiner stated:

The claims are drawn to a method of providing a decorative cover. However, the steps are directed to "selling and delivering" the sheet and not to a method of providing the cover. The steps of "selling and delivering" the sheet is directed to a method of doing business and not to the method of using the product.

In response to the rejection, the preambles of independent claims 1, 10, 20, 29, 39-43, 51, 60 and 61, and thus dependent claims 2, 4-9, 11, 13-19, 21, 23-28, 30, 32-38, 44-50 and 52-59 that depend therefrom, have been amended herein to simply recite "a method". Therefore, Applicant respectfully submits that such claims are directed to statutory subject matter, as a method of doing business is recognized as statutory subject matter, as demonstrated by the Federal Circuit's 1998 decision in *State Street Bank* (State Street Bank v. Signature Financial, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998)).

Therefore, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. 101 rejection of the claims as currently amended.

#### Applicant's Response to the 35 U.S.C. 103(a) Rejections of the Claims

In the Office Action, the Examiner rejected Applicant's claims 1-2, 5-11, 14-21, 24-30, 33-44, 46-52 and 54-61 under 35 U.S.C. 103(a) as being obvious over Weder (US 6,742,316) in view of Applicant's admission in the IDS filed on October 22, 2004; the Examiner also rejected Applicant's claims 4, 13, 23, 32, 45 and 53 under 35 U.S.C. 103(a) over the same combination of references.

As stated by the Examiner in the Office Action, the Weder ('316) patent only qualifies as prior art under subsection (e) of 35 U.S.C. 102. 35 U.S.C. 103(c) states that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Weder ('316) and the invention claimed in the subject application were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person (see Statement filed herewith). Therefore, Applicant respectfully submits that Weder ('316) is not available as prior art under 35 U.S.C. 103(a), and therefore respectfully requests reconsideration and withdrawal of the 35 U.S.C. 103(a) rejection of the claims over Weder ('316) in view of Applicant's admission in the IDS filed on October 22, 2004.

## CONCLUSION

This is meant to be a complete response to the Office Action mailed December 20, 2004. Applicant respectfully submits that each and every rejection of the claims has been overcome. Further, Applicant respectfully submits that the claims as now pending are in a condition for allowance. Favorable action is respectfully solicited.

Should the Examiner have any questions regarding this Amendment, or the remarks contained herein, Applicant's agent would welcome the opportunity to discuss such matters with the Examiner.

Respectfully submitted,



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